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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,178	03/16/2001	Toyohisa Oya	2870-0164P	5742
2292	7590	01/07/2004		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER CHEA, THORL	
			ART UNIT	PAPER NUMBER

1752

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,178

Applicant(s)

OYA ET AL.

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Examiner

Thori Chea

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1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 17-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fails to disclose the selection of V3, V6 and V12 presented in the claimed invention. All the substituents presented in the specification as originally files are all equivalent. There is nowhere in the specification suggested that the substituents V3, V6 and V12 differs form the others. Therefore, this change constitutes a new concept that the advantage thereof previously unknown, therefore, it raise the issue of matter to the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-22, 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Takeuchi or Nakamura et al (Nakamura.) in view of the combination of Cerquone et al

(Cerquone) and EP 0762196 (EP'196). Note to Takeuchi in the abstract, the exemplified compound in columns 5-20 compound I-1 to I-28, column 63, lines 49-63; Nakamura in the abstract, exemplified compound in columns 7-33, compounds (1) to (90), and column 116, lines 57-67, column 117, lines 1-4. Takeuchi and Nakamura disclose both photosensitive silver halide material and heat-development light sensitive material. In the case of a heat-development light sensitive material the light-sensitive silver halide emulsion may be used together with an organosilver salt oxidizing agent. Cerquone discloses a photothermographic material, which contains a combination of the use of the color developer for dye forming coupler and the reducing agent for silver ion. Note for instance the sulfoamidophenol and the reducing agent, which react with silver salt oxidizing agent to produce desired dye image (column 6, compound A to D and lines 50-60). EP'196 discloses a phenol compound as reducing agent for silver salt. Note for instance compound A on page 2 and compound on page 3. Therefore, it would have been obvious to use the phenol compound as reducing agent for silver ion in combination with the color developer taught in either Takeuchi or Nakamura with an expectation of producing a desired dye image, and thereby provide the invention as claimed.

5. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeuchi or Nakamura et al (Nakamura) as applied to claims 17-22, 25-27 above, and further in view of JP10339934 (JP'934). The phthalazine compound has been known in JP'934 as to provide a photothermographic material with low fog and to improve photothermographic property. See US patent no. 6,146,822 which is equivalent to the JP'934 in column 5, compound (I). It would have been to the worker of ordinary skill in the art to incorporate the phthalazine derivative taught in JP'934 for same reason, and thereby provide a material as claimed.

Response to Amendment

6. Applicant's arguments filed October 6, 2003 have been fully considered but they are not persuasive. The argument with respect to the "monochromatic" is not persuasive since the term "monochromatic" fails to differentiate the claimed material from that of the applied prior art of record. Also, the specification disclosure fails to clearly define the term "monochromatic". The Webster's Ninth New Collegiate Dictionary define the term "chromatic" as: (a) of or relating to color or color phenomena or sensation; (b): highly colored. Therefor, the claimed material is still read on a color photothermographic material. It also has been known in Cerquone to use a combination of color coupler and the reducing agent in heat developable material to produce a desired image. The phenol compound taught in the applied prior art of record may have different substituent associated therewith, but the worker of ordinary skill in the art would have been expected that the phenol compound and that of the prior art of record would work similarly because of its similar functional group (-OH), and it would perform the same function. The argument with synergistic effect made in the argument is not persuasive since it is irrelevant to the applied prior art of record. The "unexpected results" made in the argument is based on the Counsel's assertion. Counsel's arguments cannot take the place of evidence. In re Greenfield, 571 F. 2d 1185, 197 USPQ 227 (CCPA 1978). There are nowhere in the specification stating the results disclosed therein would have been found unexpected by the worker of ordinary skill in the art at the time the invention was made.

Conclusion


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571)272-1328. The

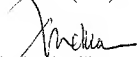
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examiner can normally be reached on M-F (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on (571)272-1385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea 
December 28, 2003


Thorl Chea
Primary Examiner
Art Unit 1752